

REMARKS

Claim 11-20 are currently pending in this application, as amended. A Request For Continued Examination (RCE) under 37 C.F.R. § 1.114 is filed herewith. Claims 1-10 have been cancelled in the interest of moving prosecution forward. Claim 18 has been amended to correct an obvious typographical error. Claim 19 has been amended to slightly clarify the claim language. No other amendments have been made. According, no new matter has been added.

Telephone Interview Summary

The Applicant wishes to thank Primary Examiner Benjamin H. Layno for extending the courtesy of a telephone interview conducted on Tuesday, April 18, 2006, with the Applicant's undersigned patent agent. The contents of a previously e-mailed draft version of a proposed claim amendment were discussed in detail.

The Applicant's patent agent first discussed a proposed amendment to the game apparatus claims to attempt to lend structure to the apparatus regarding the required rules to embrace possible implementations in gaming machines and/or casino tables limited to the Applicant's disclosed claims. Examiner Layno indicated that he would not give patentable weight to the proposed claims even using "configured to" or "arranged to language." In the interest of advancing the prosecution, Applicant has cancelled the apparatus claims, but traverses the Examiner's reasons for not giving patentable weight to the configured arrangement suggested and reserves the right to pursue the apparatus claims in a continuation and/or continuation-in-part application(s).¹

The Applicant's patent agent discussed U.S. Patent No. 5,615,888 ("Lofink et al.," hereinafter, "Lofink") in view of U.S. Patent Publication No. US2001/0040344 A1 ("Zahedi")

¹ There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971); MPEP § 2173.05(g).

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

and why these references are not properly combinable in the manner suggested by the Examiner in the most recent Office Action.

Lofink discloses removing all of the point-10 (face value 10) cards from the deck. Col. 4, lines 45-51. Lofink's rule change shifts the odds in favor of the house. In order to move the mathematical odds closer to conventional twenty-one, Lofink discloses paying all player blackjacks (i.e., a two card combination equaling a numerical count of 21) three-to-two odds, including when the dealer has blackjack. Col. 5, lines 27-40.

Zahedi discloses changing the point value of all of the jacks to 2, the point value of all of the queens to 3 and the point value of all of the kings to 4. See paragraph [0025]. The deck includes fifty-three cards with a joker. Eliminating the twelve ten-value cards (jack, queen and king) makes card counting difficult and improves the odds to the house. See paragraphs [0026]-[0027]. In order to offset the odds change, Zahedi discloses using bonus payouts on an original hand. See paragraph [0027]. Zahedi discloses paying two-to-one odds for a two-card combination equaling 21 *if* the player has selected *at least one bonus bet(s)*, even if the dealer has blackjack. So, in Zahedi, a player can only get two-card blackjack with a face value "10" and an Ace, because the jacks, queens and kings are not worth ten and only when the player places a bonus bet. See paragraph [0029]. All of the permutations of Zahedi suggested at paragraphs [0029]-[0037] include requiring the player to place a bonus bet, a joker bonus or buy insurance.

Accordingly, modifying Lofink (with the four ten cards removed) with Zahedi (eliminating the point 10 value of all of the face cards) as suggested by the Examiner would result in a broken game that can never achieve blackjack (since there would be NO value ten cards) and/or a game that requires a bonus bet in order to be paid two-to-one odds on blackjack. For example, if Lofink removed all of the "10" cards and Zahedi only pays two-card blackjack with an Ace and a "10" card, a player can never achieve blackjack. If, *arguendo*, Lofink's game were modified to include the two-to-one payout, disregarding the Zahedi rules regarding changing the face values of the jack, queen and king, the modified Lofink game would still only payout two-to-one odds on blackjack *when* the player placed a bonus bet(s).

The Examiner agreed that the combination of Lofink and Zahedi as presently suggested in the most recent Office Action did not appear to work, but the Examiner indicated that he would need to reconsider the references to tell if there was additional language which might suggest the combination upon Applicant filing an Amendment or Amendment with RCE.

Rejections under 35 U.S.C. § 102

Claims 1-10 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Lofink.

Claims 1-10 have been cancelled in order to advance prosecution, and therefore, the rejection under 35 U.S.C. § 102(b) in the present application has been effectively rendered moot.

Rejections under 35 U.S.C. § 103(a)

Claims 11-18 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lofink in view of Zahedi.

Withdrawal of the rejections of Claims 11-18 and 20 is respectfully requested for at least the following reasons.

Claims 11 and 18

Claim 11, recites, *inter alia*:

(a) removing all cards having a face value of ten from the one or more conventional decks of cards...

...

(e) paying each player having blackjack two times the respective player's wager, if the dealer does not have blackjack, blackjack being a condition when two cards add up to twenty-one.

Claim 18, recites, *inter alia*:

(a) removing all cards having a face value of ten from the one or more conventional decks of cards...

...

(e) paying each player having blackjack in the respective player's first hand two times the respective player's first wager when the dealer's face-up card in the dealer's first hand is not an Ace, Jack, Queen or King, blackjack being a condition when two cards add up to twenty-one....

Applicant respectfully submits that, for the reasons that follow, there is no suggestion in either Lofink or Zahedi to make the combination suggested by the Examiner and that making the modification suggested by the Examiner would impermissibly result in a change to the basic principle of operation of Lofink.

Lofink discloses a blackjack variation game (Spanish 21) using a forty-eight card deck including the Aces through the Nines and the Jacks, Queens and Kings, i.e., eliminating the four ten-point cards (i.e., on their face "10"). The elimination of the four ten-point cards shifts the odds of the game in favor of the house, so to make up for this difference and keep the game attractive to the players, Lofink discloses bonus payouts on the player's hand. Primarily, Lofink discloses paying all player blackjacks three-to-two odds, including when the dealer also has blackjack. See Col. 5, lines 35-38.

The Examiner acknowledges that Lofink does not disclose "paying each player having blackjack two times the respective player's wager," if "the dealer does not have blackjack" or "when the dealer's face-up card in the dealer's first hand is not an Ace, Jack, Queen or King," as recited in claims 11 and 18.

Notably, claims 11 and 18 define blackjack as "...being a condition when two cards add up to twenty-one," and not more than two-card combinations equaling 21 (e.g., not six card 21, etc.).

The Examiner asserts that Zahedi discloses that it is known in the blackjack art to pay a player having blackjack at two times (two-to-one) the respective player's wager and points to paragraph [0029]. The Examiner asserts that it would have been obvious to modify Lofink's blackjack game by requiring that player's having blackjack be paid two times the respective player's wager.

The Applicant traverses the Examiner's argument that it would have been obvious to modify Lofink by Zahedi. While the games are each blackjack variation card games, the rules of the two games are divergent and conflicting. The Examiner is merely impermissibly selectively picking and choosing among isolated portions of isolated disclosures in the prior art to deprecate the claimed invention.

It is well settled that when making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. MPEP § 2142. As the Federal Circuit has pointed out, "it is impermissible to use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988); see also, MPEP § 2142.

Zahedi discloses a blackjack variation card game where the value of the jacks, queens and kings are changed from a value of ten to a value of two, three and four, respectively. (See paragraphs [0025]-[0027] and [0116]-[0118]). Zahedi discloses changing the point value of all of the jacks to 2, the point value of all of the queens to 3 and the point value of all of the kings to 4. See paragraph [0025]. The deck includes fifty-three cards with a joker. Eliminating the twelve ten-value cards (jack, queen and king) makes card counting difficult and improves the odds to the house. See paragraphs [0026]-[0027]. In order to offset the odds change, Zahedi discloses using bonus payouts on an original hand. See paragraph [0027]. Zahedi discloses paying two-to-one odds for a two-card combination equaling 21 *if* the player has selected *at least one bonus bet(s)*. So, in Zahedi, a player can only get two-card blackjack with a face value "10" and an Ace, because the jacks, queens and kings are not worth ten and only when the player places a bonus bet. See paragraph [0029]. All of the permutations of Zahedi suggested at paragraphs [0029]-[0037] include requiring the player to place a bonus bet, a joker bonus or buy insurance.

Because of Zahedi's revaluation of the jacks, queens and kings, a player must get a ten-point card (i.e. and actual ten card) in combination with an Ace in order to get two-card blackjack in the relevant embodiment of Zahedi described in paragraph [0029]. Because of the revaluation of the jack, queen and king, Zahedi provides a rule modification to shift the odds closer to conventional twenty-one which includes paying a player at two-to-one odds. Thus, in

the game according to Zahedi, a player must get a ten-point card and an Ace to get blackjack and to be paid two-to-one odds and only if the player has selected at least one of the bonus bets.

Moreover, something in the prior art *as a whole* must suggest the desirability, and thus the obviousness of the invention. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 USPQ.2d 1434, 1438 (Fed. Cir. 1988); see also MPEP § 2143.

The Examiner has failed to consider the Lofink and Zahedi games as a whole, but instead has picked out features of Zahedi to attempt to modify Lofink. The rule changes from conventional blackjack are what determine the payouts and bonuses, not just getting blackjack. The rule changes in each are to compensate or shift the odds so that the games are still appealing to players, but making the suggested diverging rule changes would change the thrust of the Lofink and/or Zahedi game.

Lofink discloses blackjack variation game (Spanish 21) using a forty-eight card deck of cards eliminating the four ten cards. In Zahedi, the jack, king and queen are changed in value to 2, 3 and 4, respectively, leaving only the ten cards available to make a blackjack combination during play. Therefore, in order to make a payout of two-to-one odds in Zahedi, a player's hand must include a ten card.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02. The proposed modification or combination of the prior art invention being modified cannot change the principle of operation of the reference. MPEP § 2143.01. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP § 2143.01

Even if, *arguendo*, there was sufficient motivation to include the two-to-one payout rule of Zahedi in the Spanish 21 game of Lofink, the modified Spanish 21 of Lofink game could never payout blackjack because Lofink discloses removing all of the ten cards and Zahedi discloses (in the relevant embodiment) only paying out two-to-one odds when a player gets a ten card and an Ace to get blackjack and only if the player has selected at least one bonus bet. Accordingly, the modification suggested by the Examiner would *impermissibly* materially

change the principle of operation of the Lofink game, not just provide a “a game that’s more exciting to play.”

Moreover, the suggested combination would *impermissibly* result in Lofink’s game being unsuitable for its intended purpose (i.e., as a blackjack game) because a player could never achieve a blackjack payout, and the suggested combination would *impermissibly* change the basic principle under which Lofink was designed to operate.

Applicant therefore respectfully submits that claims 11 and 18 are not obvious under 35 U.S.C. § 103(a) in view of the attempted combination of Lofink and Zahedi because there is no suggestion in either reference as to the combination and/or because making the modification suggested by the Examiner would impermissibly result in a change to the basic principle of operation of Lofink and/or Zahedi. Accordingly, Applicant respectfully requests that the rejection of independent claims 11 and 18 and dependent claims 12-17 under 35 U.S.C. § 103(a) be withdrawn.

Allowable Subject Matter

The Examiner has stated that Claim 19 is allowed.

CONCLUSION

In view of the foregoing Amendment and Remarks, it is respectfully submitted that the present application, including claims 11-20, is in condition of allowance and such action is respectfully requested.

Respectfully submitted,

April 26, 2006
(Date)

By: _____

VINCENT MASCIO

JOHN D. SIMMONS

Registration No. 52,225

AKIN GUMP STRAUSS HAUER & FELD LLP

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103-7013

Telephone: 215-965-1200

Direct Dial: 215-965-1268

Facsimile: 215-965-1210

E-Mail: jsimmons@akingump.com

JDS/LLK